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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/038,415	01/03/2002	Mark B. Hodes	023987.43008	7045

7590 10/28/2003

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26 NORTH SECOND STREET
MEMPHIS, TN 38103

EXAMINER

PAIK, STEVE S

ART UNIT	PAPER NUMBER
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2876

DATE MAILED: 10/28/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/038,415	HODES, MARK B.	
	Examiner	Art Unit	
	Steven S. Paik	2876	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 July 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-6,8-24 and 28-32 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-6,8-24 and 28-32 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 28 February 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

1. Receipt is acknowledged of the Amendment filed February 03, 2003. The Amendment includes cancellation of claims 7 and 25-27.

Claim Objections

2. Claims 1-6, 8-24, and 28-32 are objected to because of the following informalities: the word "claim" in front of each numeral of claims appears to be unnecessary. Appropriate correction is required.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-6, 8-24, and 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fiala et al. (US 5,918,909) in view of over Horton et al. (US 6,354,065).

Re claims 1, 5, 6, 12, Fiala et al. discloses a package for a card with data-encoded strip and method for using the same comprising a package (30 in Fig. 1, 6.30 in Fig. 20, or 8.30 in Fig. 27), at least one component (col. 11, lines 39-42) to the products or services (e.g., telephone services, col. 1, lines 38-45), said at least one component being retained (col. 5, lines 35-40) within said package (30) when said package is in a closed position (col. 5, lines 9-14); and a card (first card C) secured to said package (30), said card having a data-encoded portion

(data-encoded strip S) being placed relative to said package (30) whereby said data-encoded portion (S) is exposed and accessible (see Fig. 1 and col. 5, lines 37-47) at the point of sale of the products or services to be delivered, said data-encoded portion (S) including data that allows the activation process (col. 5, lines 48-52) to begin through a point-of-sale activation device (col. 19, lines 52-56) where said data is associated with the products or services (i.e. pre-paid telephone service) to be delivered. The system further comprises a unique control number being associated with said personal identification number and the products or services to be delivered, the unique control number being encoded on one of said package, said card and said at least one component related to the products or services to be delivered (col. 20, lines 39-41 and col. 19, lines 8-13 and col. 20, lines 43-45).

However, Fiala does not disclose or fairly suggest that at least one component being retained within the package is a CD, CDs, CVD, or CVDs or other digital media storage services having digital media thereon that constitutes all or a portion of said products or services.

Horton et al. discloses a device and method for packing various types of equipment including computer systems. Such systems include numerous materials ranging from voluminous manuals to single sheet notices and compact discs or diskettes containing software programs. The package system has two separate spaces for various types of equipment and a setup material (30) used at the time of setup. The space for a setup material is absolutely necessary for the document contained in the package to work appropriately.

Therefore, it would have been obvious at the time the invention was made to a person having of ordinary skill in the art to have incorporated the software package system as taught by

Horton to the teachings of Fiala et al. for the purpose of ensuring only authorized use of a software product and expected performance of the software.

Regarding claim 2, Fiala in view of Horton discloses the package and method as recited in rejected claim 1 stated above, where the data-encoded portion (S) of the card includes a unique control number (col. 20, lines 39-41); and the card further includes a personal identification number applied to a surface of the card, the unique control number and the PIN being associated with one another and with the products or services to be delivered (col. 19, lines 8-13 and col. 20, lines 43-45).

Regarding claim 3, Fiala in view of Horton discloses the package and method as recited in rejected claim 1 stated above, where the package (8.30) includes a first panel (8.32) and a second panel (8.44) attached to said first panel, said first and second panels being in substantially congruent relationship with one another when said package (8.30) is in a closed position (col. 14, lines 19-30).

Regarding claim 4, Fiala in view of Horton discloses the package and method as recited in rejected claim 3 stated above, where the package (6.30) further includes a pocket (6.48) secured to one of said first (6.32) and second panels (6.44); said at least one component (col. 11, lines 39-42) related to the products or services to be delivered is retained within said pocket when said package (6.30) is closed, said at least one component being removable from the package when the package is open.

Regarding claim 8, Fiala in view of Horton discloses the package and method as recited in rejected claim 1 stated above, where the data-encoded portion (S) of said card (first card C) is a magnetic strip (col. 2, lines 8-10).

Regarding claims 9, 10 and 11, , Fiala in view of Horton discloses the package and method as recited in rejected claim 2 stated above, further including tamper evident means (38 or 38') for providing an indication if said personal identification number (PIN) is secure, where the PIN is obscured by the package (30) when the package is closed (col. 18, lines 54-67).

Re claims 13-18, Fiala et al. discloses a package comprises a first panel (6.32), a second panel (6.44) attached to said first panel, said first and second panels being in substantially congruent relationship with one another when said package is in a closed position (col. 14, lines 19-30), means for retaining (door panel 6.48 like a pocket on first panel 6.32) said at least one component related to the products or services to be delivered within said package when said package is in a closed position, said at least one component being removable from said package (6.30) when said package is in an open position (col. 11, lines 39-42), and means for securing said card to one of said first and said panels (PVC glue seals first and second panels).

However, Fiala does not disclose or fairly suggest that at least one component being retained within the package is a CD, CDs, CVD, or CVDs or other digital media storage services having digital media thereon that constitutes all or a portion of said products or services.

Horton et al. discloses a device and method for packing various types of equipment including computer systems. Such systems include numerous materials ranging from voluminous manuals to single sheet notices and compact discs or diskettes containing software programs. The package system has two separate spaces for various types of equipment and a setup material (30) used at the time of setup. The space for a setup material is absolutely necessary for the document contained in the package to work appropriately.

Therefore, it would have been obvious at the time the invention was made to a person having of ordinary skill in the art to have incorporated the software package system as taught by Horton to the teachings of Fiala et al. for the purpose of ensuring only authorized use of a software product and expected performance of the software.

Re claims 19-24 and 28, Fiala et al. discloses a package for a card with data-encoded strip and method for using the same comprising the steps of associating a personal identification number with goods or services, associating a number (unique control number encoded on a magnetic data-encoded strip on a first card C and (col. 20, lines 39-41) with said personal identification number (col. 20, lines 34-45), using a point of sale activation device (such as a card reader , col.. 19, 52-55) to transmit said number to processing apparatus, activating said personal identification number by said processing apparatus, and then activating access to the goods or services by communicating with said processing apparatus.

However, Fiala does not disclose or fairly suggest the claimed steps of providing all or a portion of said digital information being on a CD, CDs, CVD, or CVDs or other digital media storage services.

Horton et al. discloses a device and method for packing various types of equipment including computer systems. Such systems include numerous materials ranging from voluminous manuals to single sheet notices and compact discs or diskettes containing software programs. The package system has two separate spaces for various types of equipment and a setup material (30) used at the time of setup. The space for a setup material is absolutely necessary for the document contained in the package to work appropriately.

Therefore, it would have been obvious at the time the invention was made to an artisan having of ordinary skill in the art to have incorporated the software package system as taught by Horton to the teachings of Fiala et al. for the purpose of improving authenticity of the user and productivity of the software product by allowing the user to identify setup material required for setting up or installing the document in the package.

5. Claims 29-32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fiala et al. (USP 5,918,909) in view of Pearce et al. (USP 6,243,468). The teachings of Fiala et al. have been discussed above.

Fiala et al. teaches a card like a prepaid phone card having a data-encoded strip, personal identification number and a unique number to ensure proper activation for the service included in the card. However, he does not disclose or fairly suggest that registration process involving a buyer's computer and hard drive information.

Pearce et al. discloses an anti-piracy system for reducing the opportunity for piracy and illicit use of software products through a specific registration process. The software product generates a hardware ID that identifies the set of hardware components and sends it and a product ID to a registration authority (Fig. 4). Then the registration authority (provider) receives and completes the registration process and sends a registration ID to the buyer. The hardware ID includes a single bit for each of five system components: BIOS, VBIOS, RAM, hard disk drive, and floppy disk drive (col. 5, lines 61-67 and col. 6, lines 1-29). The matching process of a unique identification number (Test ID) and registration ID will eliminate unauthorized install or usage of the software.

Therefore, it would have been obvious at the time the invention was made to a person having of ordinary skill in the art to have incorporated the software anti-piracy system as taught by Pearce et al. to the teachings of Fiala et al. for the purpose of ensuring only authorized use of a software product and increasing profits.

Response to Arguments

6. Applicant's arguments with respect to claims 1-6, 8-24 and 28-32 have been considered but are moot in view of the new ground(s) of rejection.

A newly cited reference, Horton et al. (US 6,354,065), discloses a package system for a compact disc or diskettes containing software programs. However, the reference is silent about a card.

As previously discussed (paper No. 6), Fiala et al. disclose a package for a product having a digital information including a card (magnetic card) having a magnetically encoded data relative to the package for activating the product within the package at the time of sale.

It would have been obvious to an artisan of ordinary skill at the time the invention was made to incorporate the magnetic card of Fiala et al. into the software package of Horton et al. to improve authenticity of the user and minimize financial loss resulted in theft.

Accordingly, claims 1-6, 8-24, and 28-32 are rejected under 35 U.S.C. § 103(a).

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Steven S. Paik whose telephone number is 703-308-6190. The examiner can normally be reached on Mon - Fri (7:00am-3:30pm).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael G. Lee can be reached on 703-305-3503. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9306 for regular communications and 703-872-9306 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0530.

Steven Paik
Steven S. Paik
Examiner
Art Unit 2876

ssp
October 19, 2003


KARL D. FRECH
PRIMARY EXAMINER